

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bill Shapiro et al. Art Unit : 2135
Patent No. : 7,434,048 Examiner : Joseph T. Pan
Issue Date : October 7, 2008 Conf. No. : 5247
Serial No. : 10/659,874
Filed : September 9, 2003
Title : CONTROLLING ACCESS TO ELECTRONIC DOCUMENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

Applicants hereby petition for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Issue Notification mailed September 17, 2008 for the above-referenced application indicates that the Patent Term Adjustment at issuance is 812 days. Reconsideration of the Patent Term Adjustment calculation to increase PTO Delay from 933 days to 1136 days, and to increase Total PTA from 812 to 1015 days, is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a delayed 14-month first non-final Office Action on January 22, 2007, thereby according a PTO Delay of 804 days. Applicants do not dispute herein this patent term adjustment calculation for this PTO "A Delay."
- 2) Applicants filed a response to the first non-final Office Action on April 23, 2007 (received at the PTO on April 23, 2007). Applicants were accorded a delay of 1 day for a late response. Applicants do not dispute herein this patent term adjustment for Applicant Delay.
- 3) Applicants filed a Request for Corrected Filing Receipt on January 31, 2008 (received at the PTO on January 31, 2008). Applicants were accorded a delay of

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the United States Patent and Trademark Office using the EFS -WEB system on this date: November 24, 2008

91 days for a submission after allowance. Applicants do not dispute herein this patent term adjustment for Applicant Delay.

- 4) Applicants filed an Amendment under 37 CFR 1.312 after the Notice of Allowance on January 31, 2008 (received at the PTO on January 31, 2008). Applicants were accorded a delay of 29 days for a submission after allowance. Applicants do not dispute herein this patent term adjustment for Applicant Delay.
- 5) The PTO issued the patent on October 7, 2008, more than four months from the receipt of the issue fee, thereby according a PTO Delay of 129 days. Applicants do not dispute herein this patent term adjustment calculation for this PTO Delay.
- 6) The application was filed on September 9, 2003 and the patent issued on October 7, 2008, more than three years later. The earliest Request for Continued Examination was filed on August 13, 2007. No PTO Delay was calculated for issuance of the patent after three years from filing. Applicants respectfully submit that the PTO's calculation of this PTO "B Delay" contains an error and that the correct PTO Delay for issuance beyond three years from filing is 203 days, as outlined further below. The PTO Delay of 804 days ("A Delay") includes 135 days after three years from filing where "A" and B" delays overlap. Therefore, the "B Delay" of 804 days does not include the overlapping 135 days.

REMARKS

Applicants have calculated the PTA in accordance with the clear intent of Congress. As outlined in Wyeth v. Dudas (Wyeth et al. v. Jon W. Dudas, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that periods of time can "overlap" is if they occur on the same day, and if an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. "A Delays" are defined as delays by the Office under 35 U.S.C. 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than 3-year application pendency.

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The PTA for the instant patent, as currently calculated and shown on the face of the patent, relies on the premise that the application was delayed under § 154(b)(1)(B) before the initial three-year period expired.

The Wyeth court determined that this construction cannot be squared with the language of § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years,” and that “B delay” begins once the PTO has failed to issue a patent within three years, not before.

In the current PTA calculation, the Office has only given credit for the larger of “A Delay” or “B Delay,” rather than the combined sum of “A Delay” and “B Delay” (which does not include any days after three years from filing where “A” and “B” delays overlap).

In this patent, “A Delay” should be calculated as 804 days, and “B Delay” should be calculated as 203 days. Thus, the total PTO Delay, including the additional PTO delay of 129 days, should be calculated as 1136 days.

In consideration of the events described above, Applicants believe the PTA calculation of 812 days is incorrect. As such, Applicants respectfully request reconsideration of the patent term adjustment in the following manner:

- 1) Total PTO Delay should be calculated as 1136 days;
- 2) Total Applicant Delay should be calculated as 121 days; and
- 3) Total PTA should be calculated as 1015 days.

Applicants note that this patent is not subject to a terminal disclaimer.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050.

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Respectfully submitted,

Date:November 24, 2008

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